

REMARKS

In the application claims 6-9, 11, and 15-19 remain pending. Claims 1-5, 10, 12-14, 20-32 have been canceled without prejudice will be filed in a continuation application. Certain of the claims have been amended only for the purpose of improving the readability thereof. The amendments were not made for the purpose of fulfilling any statutory requirement. Support for the amendments may be found in the specification, claims, and figures as originally filed and, as such, no new matter has been added.

The pending claims presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Lord (U.S. Patent No. 6,593,967). The reconsideration of this rejection is, however, respectfully requested.

It is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that a combination of references disclose, either expressly or inherently, each and every element set forth in the claims, considering the claims “as a whole.” The requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner.

Turning now to Lord, Lord describes a system wherein a media device, as acknowledged in the Office Action, has a controller that allows it to revert to a previously viewed channel when the content on that channel reappears, i.e., the media device has a return to channel feature. Specifically, Lord describes a system in which the media device receives a “remember command” from a remote control and, in response, performs a “remember operation.” (Col. 3, lines 51-59). As part of the remember operation, the media device stores in memory a “fingerprint” of the A/V signal of media currently appearing on a channel. (Col. 4, lines 6-24). In this manner, when a “fingerprint compare unit” of the media device detects that the fingerprint of the A/V signal currently airing on the channel is sufficiently similar to the fingerprint stored in memory, the media device will revert to the channel. (Col. 6, lines 10-18). Lord further describes that the fingerprint compare unit can adjust the confidence thresholds, i.e., the degree to which the fingerprints must be sufficiently similar, as a function of time. (Col. 32-52). Thus, Lord clearly describes a system in which the media device: 1) is preprogrammed to recognize a special “remember” command that is transmitted from a remote control; and 2) always considers the state of media currently airing on a channel, whether it be the state of the media alone or the state of the media with further consideration give to time.

In contrast to the system and method described in Lord, the present invention is embodied in a remote control which has the advantage, unrecognized by Lord, of allowing any media device, even those without the programming necessary for performing a “remember” operation, to nevertheless have a return to channel feature. To this end, in response to activation of a button of the remote control, rather than transmit a special “recommend” command to the device (as is required by Lord), the claimed remote control stores a primary channel indicator in memory, starts a timer to measure a time interval, and, in response to expiration of the time interval,

transmits a signal to the media device to cause the media device to return to the primary channel. Thus, the claims are distinguishable over Lord for the simple reason that the claimed remote control itself performs all of the steps necessary to effectively provide to any of a plurality of devices of different types and makes a return to channel feature without regard to whether or not the device itself is preprogrammed to include that feature (as in the case of the device described in Lord).

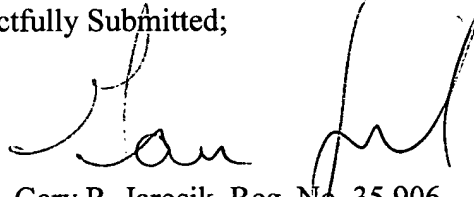
While the Office Action is correct in acknowledging that the teachings of Lord fail to anticipate or render obvious the invention claimed, it is respectfully submitted that, in this case, “legal precedent” cannot be used to demonstrate that it would have been obvious to modify Lord in the manner espoused in the Office Action. In this regard, while the Office Action has asserted that it would have been obvious, in view of legal precedent, to “integrate the remote 25 and the controller 20 which would reduce the number of separate elements in the system and increase the number of components/software in remote 24,” it is respectfully submitted that such a modification would be contrary to the express teachings of Lord. Specifically, as discussed above, Lord describes a system that relies upon and always compares a current fingerprint of an A/V signal with a stored fingerprint of an A/V signal to determine if the current fingerprint “is sufficiently similar” to the stored fingerprint before sending a “match detected signal” to the controller to thereby return to channel. However, the modification espoused in the Office Action would impermissibly remove this required step of comparing from the Lord system. In particular, moving the controller to the remote control, as has been espoused in the Office Action, would change the very principle of operation of Lord since it would no longer allow for the required comparison of a current fingerprint of an A/V signal with a stored fingerprint of an A/V signal. Since an espoused modification which would change the principle of operation of

the reference being modified is not sufficient to demonstrate that one of skill in the art would have selected the various parts from the references and combined them in the claimed manner, it is respectfully submitted that a *prima facie* case of obviousness has not been presented and that the rejection of the claims must be withdrawn. *In re Ratti*, 270 F.2d 810 (CCPA 1959) (If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious).

CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

Respectfully Submitted;



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